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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK DOEPKE and DOUGLAS DEVORE

Appeal 2009-005856
Application 10/826,415[1]
Technology Center 2100

Decided: June 4, 2010

Before LEE E. BARRETT, LANCE LEONARD BARRY, and JEAN R. HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Filed on April 16, 2004. The real party in interest is Apple, Inc. (Br. 3.)

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 1 through 35. (Br. 2.)[2] We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm.

Appellants' Invention

Appellants invented a method, system, and program storage medium for automatically assembling a user-specified video transition. (Spec. 1, para. [0001].)

Illustrative Claim

Independent claims 1 and 22 further illustrate the invention as follows:

> 1. A method to specify a multimedia transition, comprising:
>
> identifying a plurality of multimedia assets that define a transition, wherein at least one of the plurality of multimedia assets is user-supplied independent of any multimedia assets provided by a video editing application;
>
> identifying a source multimedia object;
>
> identifying a target multimedia object;
>
> compositing the multimedia assets that define the transition with the source and target multimedia objects to create a result; and

[2] All references to the Appeal Brief are to the Appeal Brief filed on December 20, 2007, which replaced the prior Appeal Brief filed on September 25, 2007.

making the result available for use by the video editing application.

22. A method for generating a user-defined transformation using a video editing application, the method comprising:

identifying a first movie that is independent of any movie provided by the video editing application;

identifying an x-asset key that is independent of any x-asset key provided by the video editing application, wherein the x-asset key comprises at least one second movie; and

compositing a transformation by combining the first movie and the second movie in accordance with the x-asset key.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Peters	5,528,310	Jun. 18, 1996
Newman	6,154,600	Nov. 28, 2000
Sideman	2002/0116716 A1	Aug. 22, 2002
Pettigrew	6,445,816 B1	Sep. 3, 2002
Harville	2004/0218894 A1	Nov. 4, 2004
White	6,909,438 B1	Jun. 21, 2005

Rejections on Appeal[3]

The Examiner rejects the claims on appeal as follows:

Claims 1 through 4, 6 through 8, 11, 12, and 14 through 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Newman.

[3] The Examiner withdrew the 35 U.S.C. § 112, first paragraph, rejection of claims 1 through 21. (Ans. 25.) The Examiner also withdrew the 35 U.S.C. § 101 rejection of claims 1 through 21. (*Id.*)

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Newman and White.

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Newman, White, and Harville.

Claims 13, 21, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Newman and Sideman.

Claims 22, 26 through 28, 34, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Newman.

Claims 23 through 25 and 31 through 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Newman and Pettigrew.

Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Newman and Peters.

Appellants' Contentions

Appellants contend that Newman's disclosure of an editor that provides transitions in the form of default transitions in a graphical user interface ("GUI"), whereby the transitions are used to combine hypermedia supplied by a user, does not teach a user supplying transitions independent of any multimedia assets provided by a video editing application. (Br. 10.) Further, Appellants argue that Newman's disclosure of capturing hypermedia and editing source and target media with one of Newman's multiple transitions does not amount to defining a transition, as claimed. (*Id.* at 10-11.) Therefore, Appellants allege that Newman does not teach "at least one of the plurality of multimedia assets is user-supplied independent of any multimedia assets provided by a video editing application," as recited in independent claim 1. (*Id.*)

Examiner's Findings and Conclusions

The Examiner finds that Newman's disclosure of allowing a user to capture clips from sources, such as broadcast radio, television, the World Wide Web ("WWW"), off-line source, etc., teaches a user supplying transitions independent of any multimedia assets provided by a video editing application. (Ans. 25-26.) Further, the Examiner finds that Appellants define "a user-supplied multimedia asset" in the Brief as not being predefined or preinstalled within the video editing program. (*Id.* at 26.) In particular, the Examiner finds that Newman's disclosure of the clips captured from the WWW are not predefined or preinstalled within a video editing application and, therefore, teach the disputed limitation. (*Id.* at 26-27.)

II. ISSUE

Have Appellants shown that the Examiner erred in finding that Newman anticipates independent claim 1? In particular, the issue turns on whether Newman teaches "at least one of the plurality of multimedia assets is user-supplied independent of any multimedia assets provided by a video editing application," as recited in independent claim 1.

III. FINDINGS OF FACT

The following Findings of Fact ("FF") are shown by a preponderance of the evidence.

Newman

1. Newman generally relates to non-linear editing systems and, in particular, to a media editor that stores, edits, and retrieves audio or visual information. (Col. 1, ll. 19-21.)

2. Newman discloses that the editing system allows consumers to capture hypermedia from real-time on-line sources, including broadcast radio, television, pay per view cable, satellite television services, the WWW, and off-line sources (e.g., video cassette tapes, laserdiscs, digital video discs ("DVDs"), and compact discs). (Col. 3, ll. 53-58.)

3. Newman discloses that consumers can utilize a GUI to selectively capture and manipulate hypermedia portions, or clips. (*Id.* at ll. 60-63.) In particular, Newman discloses that captured clips appear as icons on the GUI. (*Id.* at ll. 63-64.) Newman discloses that consumers can combine captured clips by manipulating the icons in order to effect a wide variety of editing functions, including fades, dissolves, wipes, and animated effects. (*Id.* at ll. 64-67.)

IV. PRINCIPLE OF LAW

Claim Construction

"[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (citations omitted). "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d at 1323.

Anticipation

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)).

> Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.

Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed Cir. 1999) (internal citations omitted).

Obviousness

"On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of

nonobviousness." *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (citation omitted).

V. ANALYSIS

35 U.S.C. § 102(b) Rejection

Claim 1

Independent claim 1 recites, in relevant part, "at least one of the plurality of multimedia assets is user-supplied independent of any multimedia assets provided by a video editing application."

As detailed in the Findings of Fact section, Newman discloses an editing system that stores, edits, and retrieves audio or visual information. (FF 1.) In particular, Newman discloses that the editing system captures hypermedia clips from a variety of on-line sources, including but not limited to the broadcast radio, television, and the WWW. (FF 2.) Further, Newman discloses utilizing a GUI that selectively captures, manipulates, and combines clips. (FF 3.) Additionally, Newman discloses that the GUI performs a wide variety of editing functions, including fades, dissolves, wipes, and animated effects. (*Id.*)

We find that Newman's disclosure teaches an editing system that utilizes a GUI to selectively capture, manipulate, and combine clips from the WWW. In particular, we find that by capturing, manipulating, and combining clips from the WWW, Newman discloses that a user can independently retrieve images or movies from the WWW and, subsequently, select fades, dissolves, wipes, or animated effects in order to allow a video application program to transition a first image or movie into a second image or movie. Thus, we find that Newman teaches the disputed limitation. It

follows that Appellants have not shown that the Examiner erred in finding that Newman anticipates independent claim 1.

Claims 2 through 4, 6 through 8, 11, 12, and 14 through 20

Appellants do not provide separate arguments for patentability with respect to independent claim 14 and dependent claims 2 through 4, 6 through 8, 11, 12, and 15 through 20. Therefore, we select independent claim 1 as representative of the cited claims. Consequently, Appellants have not shown error in the Examiner's rejection of independent claim 14 and dependent claims 2 through 4, 6 through 8, 11, 12, and 15 through 20 for the reasons set forth in our discussion of independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2009).

35 U.S.C. § 103(a) Rejection

Claim 22

Appellants contend that Newman's disclosure of generating transitions between capture hypermedia by allowing a system or a user to select transitions that become part of an editor does not teach "identifying an x-asset key that is independent of any x-asset provided by the video editing application," as recited in independent claim 22. (Br. 11-12.) We do not agree.

We first consider the scope and meaning of the term "an x-asset key," which must be given the broadest reasonable interpretation consistent with Appellants' disclosure, as explained in *In re Morris*, 127 F.3d 1048 (Fed. Cir. 1997):

> [T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in

> the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

Id. at 1054. *See also Zletz*, 893 F.2d at 321 (stating that "claims must be interpreted as broadly as their terms reasonably allow.") Appellants' Specification defines "an x-asset key" as:

> *[a] collection of all assets for a transformation including movies and parameters.* An x-asset key may include, but is not limited to, an asset-movie, an asset matte movie, a background matte movie, a scalp map movie, a displacement map movie, a luminosity map movie, a zoom-x map movie and a zoom-y map movie.

(Spec. 7, ll. 18-22.) (Emphasis added)

Further, Appellants' Specification states that:

> [a]ll assets (e.g., movies or parameters) within the x-asset key may be located in one location, such as a designated file directory or folder in a computer system or they may be physically distributed across a networked computer system.

(Spec. 8, ll. 2-5.)

Our reviewing court further states, "the 'ordinary meaning' of a claim term is its meaning to the ordinary artisan after reading the entire patent." *Phillips v. AWH Corp.*, 415 F.3d at 1321.

Upon reviewing Appellants' Specification, we find that the claim term "an x-asset key" may be broadly, but reasonably construed as a collection of movies or parameters stored in a designated file, directory, or folder in a computer system.

As set forth above, we find that Newman's editing system independently retrieves images or movies from the WWW and, further, allows a user to select editing functions that transition a first image or movie

into a second image or movie. *See supra disc.* at 8. In particular, we find that an ordinarily skilled artisan would have recognized that Newman's editing system allows a user to store the independently retrieved images or movies therein. Therefore, consistent with the definition above, Newman's disclosure of storing the independently retrieved images or movies in the editing system amounts to identifying a collection of movies or parameters stored in a designated file, directory, or folder in a computer system. Thus, we find that Newman teaches the disputed limitation. It follows that Appellants have not shown that the Examiner erred in concluding that Newman renders independent claim 22 unpatentable.

Claims 5, 9, 10, 13, and 21 through 35

Appellants do not provide separate arguments for patentability with respect to independent claim 28 and dependent claims 5, 9, 10, 13, 21, 23 through 27, and 29 through 35. Therefore, we select independent claim 22 as representative of the cited claims. Consequently, Appellants have not shown error in the Examiner's rejection of independent claim 28 and dependent claims 5, 9, 10, 13, 21, 23 through 27, and 29 through 35 for the reasons set forth in our discussion of independent claim 22. *See* 37 C.F.R. § 41.37(c)(1)(vii).

VI. CONCLUSIONS OF LAW

1. Appellants have not shown that the Examiner erred in rejecting claims 1 through 4, 6 through 8, 11, 12, and 14 through 20 as being anticipated under 35 U.S.C. § 102(b).

2. Appellants have not shown that the Examiner erred in rejecting claims 5, 9, 10, 13, and 21 through 35 as being unpatentable under 35 U.S.C. § 103(a).

VII. DECISION

1. We affirm the Examiner's decision to reject claims 1 through 4, 6 through 8, 11, 12, and 14 through 20 as being anticipated under 35 U.S.C. § 102(b).

2. We affirm the Examiner's decision to reject claims 5, 9, 10, 13, and 21 through 35 as being unpatentable under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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